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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/911,184	07/23/2001	Peter David Stokes	24615.00300	2589

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EXAMINER

TON, ANABEL

ART UNIT PAPER NUMBER

2875

DATE MAILED: 05/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/911,184

**Applicant(s)**

STOKES ET AL.

**Examiner**

Anabel M Ton

**Art Unit**

2875

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5,8-2,23-31 and 37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 37 is/are allowed.
- 6) ☒ Claim(s) 1-5,8-12,21,23-26,29-31 is/are rejected.
- 7) ☒ Claim(s) 13-20,27 and 28 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-5,8-12 and 21,23-26,29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chien and further in view of Boodle (6,276,634).
3. Chien discloses the claimed invention except for the recitation of sealing the internal member within the slot. Boodle discloses the teaching of sealing a photoluminescent strip between two covering strips that enclose it (col.8 lines 42-47). Chien discloses providing an elongate hollow outer member (6) and an elongate inner member (5) having photoluminescent material on at least one side, said outer member being of unitary box-section having first and second major wall portions and opposed side wall portions (17), said first and second major wall portions extending between and integral with said side wall portions to define a longitudinally extending slot, and push-fitting said inner member in said outer member from one end of said outer member whereby said inner member is surrounded and enclosed by said first and second major wall portions of opposed side wall portions of said outer member(col. 5 lines 1-8), wherein said outer member is formed with an internal longitudinal slot for inserting said inner member. Boodle discloses sealing said an inner photoluminescent member within

a slot. It would have been obvious to one of ordinary skill in the art at the time the invention was made to seal the inner member of Chien within the slot since as taught by Boodle, sealing a photoluminescent strip within a covering to prevent any intrusion of harmful external elements into the slot holding the photoluminescent strip.

- Outer member is made of a light transmitting material.
- Outer member is made of transparent or translucent plastics.
- Inner member is sufficiently rigid to be push fitted in said outer member.
- Said inner member is made of metal coated on at least one side with photoluminescent material (col. 6 lines 50-56, Boodle)
- Said inner member is removable from said outer member (Chien col. 5 lines 1-8)
- The track can be laid to present either one of two major surfaces of said outer member uppermost with said photo luminescent material of said inner member disposed to emit light through said uppermost surface (Chien fig. 1);
- Said inner member has photoluminescent material on one side only and is reversible to present said photoluminescent side uppermost in both orientations of said track.
- With regards to the inner member having photoluminescent material on both sides, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the PL material on both sides of the inner member since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.* 193 USPQ 8.

- Said outer member is compressed in a direction transverse to its length after said inner member has been inserted to reduce the depth of said track (col. 7 lines 1-10, Chien).
- Said closure comprises an end cap that can be removed if it is desired to remove said inner member, (col. 2 lines 55-59, Boodle).
- Said inner member is the same or substantially the same length as said outer member.
- Wherein said inner member is substantially the same width as said outer member.
- Said outer member is symmetrical enabling said outer member to be laid either way up.
- Said major wall portions of said outer member have substantially planar outer surfaces.
- Said outer surface of at least that major wall portion overlaying said photoluminescent material is provided with formations having anti-slip characteristics (Boodle).
- With regards to said outer surface of at least that major wall portion overlaying said photoluminescent material being provided with formations having anti-slip characteristics, and wherein said formations are restricted to side edge regions of said outer surface, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the photoluminescent lighting panel of Chien with formations having anti-slip characteristics since as taught by

Boodle, these formations on such a lighting device is old and well known in the art for the purpose of providing an anti slip surface, further more, although Boodle discloses these surfaces on side portions of the lighting device (Fig 6), it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japiske*, 86 USPQ 70. .

#### ***Allowable Subject Matter***

4. Claims 13-20,27,28 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

5. Claim 37 is allowed.

- Said assembled track is passed between a pair of pressure rollers engaging said top and bottom surfaces of said outer member.
- A method of manufacturing a photoluminescent track for an emergency lighting system comprising providing an elongate hollow outer member and an elongate inner member having photoluminescent material on at least one side, and push-fitting said inner member in said outer member from one end, wherein said outer member is compressed in a direction transverse to its length after said inner member has been inserted to reduce the depth of said track, wherein said

assembled track is passed between a pair of pressure rollers engaging said top and bottom surfaces of said outer member.

***Response to Arguments***

6. Applicant's arguments filed 03/05/04 have been fully considered but they are not persuasive. Applicant argues that combining Chien and Boodle fail to teach "sealing said inner member within said slot" and that applicant admits that although Boodle teaches only "vacuum sealing a photoluminescent strip between two covering strips" this teaching is completely different from what the instant invention teaches. Examiner disagrees since a slot a narrow opening or groove; the internal space provided and formed by the two covering strips would automatically form a slot. At the point of assembly the photoluminescent strip is placed in between these two covering strips to form a slot and subsequent to this assembly is sealed between the two strips.

7. In response to applicant's argument that even if Chien and Bodle are combined Chien's device requires a combination of an EL and PL strip, the EL strip requiring connection from an exterior power source and that Chien is not suited for sealing since terminals must necessarily extend therefrom, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Furthermore, applicant is directed to column 5 lines 58-65 of Chien where it is taught that the lighting arrangement is made

*without any additional wiring* since the strips and panels have their own individual power sources (hence no need for external power sources).

8. With regards to applicant's argument that " an outer member being of a unitary box section having a first and second major wall portions and opposed side wall portions" is not taught by either Chien or Bodle, applicant is directed to figure 6 of Bodle where is an outer member being of a unitary box section (track underneath panel 60) having a first and second major wall portions (walls at the side of 63) and opposed wall portions (inherent since all figures show a cut portion of the entire device, opposed wall portions to each track would be where they end on a proximal and distal end of the track respectively)

### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.



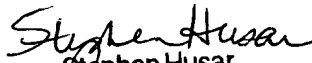
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anabel M Ton whose telephone number is (571) 272-2382. The examiner can normally be reached on 08:00-16:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (571) 272-2378. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Anabel M Ton  
Examiner  
Art Unit 2875

AMT

  
Stephen Husar  
Primary Examiner